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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MIRZA, ADNAN M

ART UNIT PAPER NUMBER

2145

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,230

Applicant(s)

BRICKLIN ET AL.

Examiner

Adnan M Mirza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36, 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-36,39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (U.S. 2002/019404) and Hanson et al (U.S. 6,691,153).

As per claim 1,15,29,33 Boyd disclosed a method for facilitating a chat service from a web site, the web site consisting of web pages and executable program routines stored on an http server, the http server coupled via a computer network to a plurality of subscriber computers each operated by at least one of the subscribers, the method comprising: a. transmitting a web page to one of the subscriber computers (Page. 3, Pg. 0031), the web page including a hypertext link corresponding to a chat environment facilitating communication among chat participants, the web page also including an indication of the extent to the which the chat participants using the chat environment are compatible with user of the one of the subscriber computers (Page. 7, pg. 0076-0077); b. receiving a request for the chat environment from the one of the subscriber computers (Page. 7, pg. 0075); c. causing the chat environment to be generated on the one of the subscriber computers, the chat environment depicted as a chat environment on a display device associated with the one of the subscriber computers when processed by an application program operating on the one of the subscriber computers (Page. 5, pg. 0048), d. facilitating the

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establishment of a connection between the one of the subscriber computers and a chat server such that the one of the subscriber computers is logged onto a chat a channel corresponding to the generated chat environment (Pg. 7, pg. 0079).

Boyd did not disclose in detail the depicted chat environment including an area for chat messages, a plurality screen images, each one of the plurality of screen images associated with a corresponding one of the chat participant, and a plurality of compatibility indicator sets, each one of the indicator sets associated with a corresponding one of the chat participant.

In the same field of endeavor Hanson disclosed the image server may be implemented using a web server (servlet). The image server takes information from hypertext Transfer Protocol (HTTP) requests from the participants 1-4 and translates the information using predefined schemes into human viewable images that are eroded in a format compatible with know web browsers. The image server may be configured separately from the web server (col. 8, lines 43-50).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have incorporated the image server may be implemented using a web server (servlet). The image server takes information from hypertext Transfer Protocol (HTTP) requests from the participants 1-4 and translates the information using predefined schemes into human viewable images that are eroded in a format compatible with know web browsers. The image server may be configured separately from the web server as taught by Hanson in the method of

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Boyd to provide additional navigation and set-up of non-proprietary participants. Additionally, participants may not be able to effectively communicate when the group becomes too large and it becomes more costly (Hanson, col. 2, lines 21-26).

3. As per claims 2,16 Boyd-Hanson disclosed wherein the request includes a chat room number where the chat environment and chat channel correspond to the chat room number (Boyd, Page. 10, Pg. 0117).

4. As per claims 3,17 Boyd-Hanson disclosed wherein the hypertext link is incorporated in an image map, the image map being incorporated in the web page (Hanson, col. 7, lines 41-53).

5. As per claims 4,18 Boyd-Hanson disclosed wherein the image map is depicted as a button on the display device when processed by the web browser (Boyd, Page. 10, Pg. 0117)).

6. As per claims 5,19 Boyd-Hanson disclosed where the chat room number corresponds to one of a plurality of chat room identifiers, the plurality of chat room identifiers stored in a database connected to the http server (Boyd, Page. 10, Pg. 0117).

7. As per claims 6,20 Boyd-Hanson disclosed wherein the chat room identifiers are organized in the database in a hierarchy of lobbies and sub-lobbies (Boyd, Page. 10, Pg. 0117).

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8. As per claims 7,21 Boyd-Hanson disclosed wherein the lobbies correspond to stored topic of conversation data (Hanson, col. 11, lines 49-59).

9. As per claims 8,22 Boyd-Hanson disclosed wherein the sub-lobbies each correspond to sub-topic of conversation data, the sub-topic of conversation data corresponding to the topic of conversation data of one of the lobbies (Hanson, col. 11, lines 49-59).

10. As per claims 9,23 Boyd-Hanson disclosed wherein each one of the compatibility indicator sets comprise a friendship indicator and a relationship indicator (Boyd, Page. 3, Pg. 0026).

11. As per claims 10,24 Boyd-Hanson disclosed further comprising the step of determining the friendship indicator by comparing retrieved profile data for a user corresponding to the one of the subscriber computers with retrieved profile data for the corresponding chat participant (Boyd, Page. 6, Pg. 0067).

12. As per claims 11,25 Boyd-Hanson disclosed wherein the retrieved profile data comprises data reflecting specified areas of interest (Boyd, Page. 6, Pg. 0067).

13. As per claims 12,26 Boyd-Hanson disclosed further comprising the step of determining the friendship indicator by checking retrieved profile data for a user corresponding to the one of the subscriber computers and retrieved profile data for the corresponding chat participant to

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determine whether the user and chat participant share an area of interest combination (Boyd, Page. 6, Pg. 0067).

14. As per claims 13,27 Boyd-Hanson disclosed further comprising; the step of determining the relationship indicator by comparing retrieved profile data for a user corresponding to the one of the subscriber computers with retrieved profile data for the corresponding chat participant (Boyd, Page. 6, Pg. 0059).

15. As per claims 14,28 Boyd-Hanson disclosed wherein the retrieved profile data comprises data reflecting qualities desired in a mate (Boyd, Page 6, Pg. 0069-0070).

16. As per claims 30,34 Boyd-Hanson disclosed wherein the retrieved profile data comprises data reflecting specified areas of interest (Boyd, Page. 6, Pg. 0065).

17. As per claims 31,35 Boyd-Hanson disclosed wherein the retrieved profile data comprises data reflecting qualities desired in a mate (Boyd, Page. 6, Pg. 0065).

18. As per claims 32,36 Boyd-Hanson disclosed wherein the step of determining a compatibility value for each one of the plurality of chat channels in relation to a user subscriber also comprises using area of interest combination data (Boyd, Page. 6, Pg. 0065-0067).

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19. As per claims 39-41 Boyd-Hanson disclosed a server having a web site comprised of web pages and chat environments stored thereon, the server coupled to a plurality of client computers, the web site serving the subscriber community having a plurality of members, the web pages being accessible to the plurality of members, the server comprising: a. a central processing unit with associated memory; b. a chat environment software element comprising instructions residing in the memory, that when executed by the central processing unit, functions to: i. Retrieve profile data for a plurality of chat participants, each one of the chat participants being logged onto one of a plurality of chat channels (Hanson, col. 6, lines 51-65); ii. Determine a compatibility value for each one of the plurality of chat channels in relation to a user subscriber using the retrieved profile data; iii. Determine a one of the plurality of chat channels having an optimal compatibility value; iv. Transmit a chat environment corresponding to the one of the plurality of chat channels to one of the client computers; and v. facilitate the establishment of a connection between the one of the client computers and a chat server such that one of the client computers is logged onto the one of the plurality of chat channels (Boyd, Page. 6, pg. 0065-0067); and c. a virtual data software element comprising instructions residing in the memory, which when executed by the central processing unit, i. Transmit a chat environment to first of the client computers, the depicted chat environment including an area for chat messages; ii. Transmit a copy of the chat environment to a second of the client computers; iii. Facilitate the establishment of a connection between the first of the client computers and a chat server that the first of the client computers is logged onto a private chat channel (Boyd, Page. 6, Pg. 0060, 0067).

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Applicant's arguments are as follows:

20. Applicant argued that prior art did not establish a prima case of obviousness, patent examiners are required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the references or to combine reference teachings; (2) there must be reasonable expectation of success; and (3) the prior art reference, or combination of references, must teach or suggest all the claim limitations.

As to applicant's arguments In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide additional navigation and set-up of non-proprietary participants. Additionally, participants may not be able to effectively communicate when the group becomes too large and it becomes more costly (Hanson, col. 2, lines 21-26).

21. Applicant argued that prior art did not disclose a chat service, particularly one that identifies the compatibility of other chat participants.

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As to applicant's arguments Hanson disclosed a discussion is composed of an initial discussion topic (series of topics, or group of sub topics) and the comments of the participants. The process is the exploration of the topic. The addition modification, or deletion of a comment represents a new state in the discussion process. Discussion can be single or multi-threaded. Initially, one of the participants accesses a live electronic form 600 (FIG. 8) by executing step 501. The initiating participant may access form similar to the form described above (col. 13, lines 56-66). One ordinary skill in the art at the time of the invention interpreted the discussion environment as chat environment.

Conclusion

22. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (703)-305-4633.

24. The examiner can normally be reached on Monday to Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dharia Rupal can be reached on (703)-305-4003. The fax for this group is (703)-746-7239.

25. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label "PROPOSED" or "DRAFT");

(703)-746-7239 (For Official Communications Intended for entry, please mark "EXPEDITED PROCEDURE"),

(703)-746-7238 (For After Final Communications).

26. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

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Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:

Hand-delivered responses should be brought to 4th Floor Receptionist, Crystal Park II,
2021 Crystal Drive, Arlington, VA 22202.

AM

Adnan Mirza

Examiner

[Signature]
JASON CARROLL
Primary Examiner
AU 2145